

REMARKS/ARGUMENTS

This Amendment is submitted in response to the Office Action mailed January 6, 2005. At that time, claims 1-18 were pending in the application. In the Office Action, the Examiner rejected claims 1, 2, 5, 7, 9-12, 15 and 18 under 35 U.S.C. § 102(b) as being anticipated by PCT Application No. WO 98/53581 to Gaw et al. (hereinafter "Gaw"). The Examiner also rejected claims 3, 4, 8, 13, 14, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Gaw in view of U.S. Patent No. 6,336,137 to Lee et al. (hereinafter "Lee"). Finally, claims 6 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaw in view of U.S. Patent No. 5,956,487 to Venkatraman et al. (hereinafter "Venkatraman").

By this Amendment, independent claims 1 and 10 have been amended. Accordingly, in view of these amendments and the following remarks, reconsideration and allowance of claims 1-18 is respectfully requested.

I. Rejection of Claims 1, 2, 5, 7, 9-12, 15 and 18 Under 35 U.S.C. § 102(b)

The Examiner rejected claims 1, 2, 5, 7, 9-12, 15 and 18 under 35 U.S.C. § 102(b) as being anticipated by Gaw. See Office Action, p. 2. This rejection is respectfully traversed.

As explained by the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

As a result of the present paper, claims 1, 2, 5, 7, 9-12, 15 and 18 recite that the "HTTP server is further configured to determine whether third party software is necessary to process a data request sent by the web client." This claim element is not taught or disclosed by Gaw. Specifically,

Gaw discloses a server system (12) that accesses control data through web browsers over a network, communicates with various devices (20-28), and performs protocol conversion by translating data to and from a generic control protocol. See e.g., Gaw, p. 1, lines 9-12. This disclosure regarding the server (12), however, does not anything related to determining whether or not third party software is necessary or even whether such third party software is available to the server (12). Accordingly, because Gaw does not teach this claim element regarding determining the necessity of third party software, this reference cannot anticipate these claims under 35 U.S.C. § 102(b). Withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 3, 4, 8, 13, 14 and 17 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 3, 4, 8, 13, 14 and 17 under 35 U.S.C. § 103(a) based on the combined teachings of Gaw and Lee. See Office Action, p. 4. This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

As discussed above, Gaw does not disclose each and every claim element found in the rejected claims. The Examiner has cited Lee for its alleged disclosure of the use of HDML, WML, and the use of servlets. See Office Action, pages 4-5. However, this particular disclosure in Lee does not teach the claim elements noticeably absent from Gaw. Therefore, the combination of Gaw and Lee does not teach all claim elements found in the present claims. Consequently, the combination of Gaw and Lee does not render the rejected claims obvious under 35 U.S.C. §103(a). Withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 6 and 16 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 6 and 16 under 35 U.S.C. § 103(a) based on the combination of Gaw and Venkatraman. See Office Action, p. 5. This rejection is respectfully traversed.

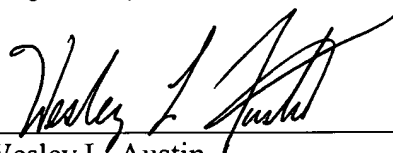
As described above, a patent claim is not *prima facie* obvious under 35 U.S.C. § 103(a) unless each and claim element is taught or suggested by the references. See M.P.E.P. § 2142; In re Royka, 180 USPQ 580 (C.C.P.A. 1974). It has already been established that Gaw does not teach or suggest all of the elements of the present claims. Venkatraman is cited by the Examiner for its alleged disclosure of a web-based multimedia user interface. However, this particular disclosure in Venkatraman does not teach the claim elements absent from Gaw. Accordingly, this combination of Gaw and Vendkatraman still does not teach or suggests all of the claim elements found in the present claims, and as such, these references do not render the present claims *prima facie* obvious under 35 U.S.C. §103(a). Withdrawal of this rejection is respectfully requested.

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IV. Conclusion

Based upon the foregoing, Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin", is written over a horizontal line.

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